

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-16 are presently active in this case. None of the claims are herewith amended.

In the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan et al. (U.S. Patent No. 6,075,982, herein "Donovan") in view of Kennedy, III et al. (U.S. Patent No. 6,009,330, herein "Kennedy") and Gottesman (U.S. Patent No. 5,898,766). Claims 2-3 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Gottesman in view of Walker (U.S. Patent No. 5,825,863) and further in view of Kasai et al. (U.S. Patent No. 5,815,560, herein "Kasai"). Claim 4 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy, Gottesman, and further in view of Walker, Kasai and Alvesalo (U.S. Patent No. 5,384,824). Claim 5 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy, Gottesman, and in view of Walker. Claims 6 and 13 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Gottesman, and in view of Joensuu et al. (U.S. Patent No. 5,966,653, herein "Joensuu"). Claims 7, 9 and 11 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Gottesman, and in view of Kasai. Claim 8 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy, Gottesman, and in view of Kasai and Sjödin (U.S. Patent No. 6,631,140). Claims 10 and 14 were rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Gottesman, and in view of Kasai and Joensuu. Claim 12 was rejected under 35 U.S.C. §103(a) as unpatentable over Donovan in view of Kennedy and Gottesman, and in view of Kasai, Sjödin and Joensuu.

In response to the rejection of independent Claim 1 under 35 U.S.C. §103(a), Applicants respectfully requests reconsideration of this rejection and traverse the rejection, as discussed next.

Briefly recapitulating, Applicants' independent Claim 1 relates to a telecommunications method for establishing a connection with a mobile device of a participant. The method includes, *inter alia*: ***sending a message including a destination number from the mobile device to a callback computer, the message including information which requests a call from the mobile device to the destination number***; and establishing a connection by the callback computer between the mobile device of the participant and the destination number, wherein the connection is established only if a remaining credit of the participant exceeds a predetermined amount. Independent Claim 7 recites similar features in the context of a system for establishing connection with a mobile device.

As explained in Applicants' specification from page 1, line 29, to page 2, line 2, and with corresponding Figure 1 as a non-limiting example, Claim 1 improves upon background telecommunication methods, since the method makes it possible to establish a prepaid connection with a mobile device of a participant who is located in a visited Public Land Mobile Network (PLMN).

Turning now to the applied references, Donovan describes a call delivery system for delivering a call to a mobile unit on a vehicle; and Kennedy describes a mobile switching center for accepting calls from a wireless handset. Donovan and Kennedy, however, fail to teach or suggest Applicants' claimed telecommunications method for establishing a connection with a mobile device of a participant. In particular, and as acknowledged by the outstanding Office Action,¹ Donovan as well as Kennedy fail to teach or suggest sending a message from the mobile device to a callback computer, the message including information

¹ See outstanding Office Action at page 3, lines 18-19.

which requests a call from the mobile device to the destination number, as recited in Applicants' Claim 1.

However, the outstanding Office Action rejects Applicants' Claim 1 based on the proposition that Gottesman teaches a short message from the mobile device to a call back computer including the call request,² and that it would have been obvious to modify Donovan and Kennedy by importing this feature from Gottesman to arrive at Applicants' Claim 1. However, Applicants respectfully disagree, and submit that Gottesman fails to teach or suggest the claimed message including information which requests a call from the mobile device to the destination number, as next discussed.

The outstanding Office Action relies on Gottesman's text at column 3, lines 42-46. In this passage, Gottesman merely recites "the user presses keys on the terminal to transmit a message requesting a call, e.g. comprising the number of the server which the user desires to access. In an example, ... the user seeks to set up a call with the server of the local electricity utility." As further detailed in Gottesman at column 3, lines 47-50, the user sets up the call on his own request by using the exchange to contact the server. In other words, Gottesman's teachings are directed to "a method that comprises setting up a call (A3-A5) between a user and the server via an exchange, and transmitting user identification data to the server."³ Accordingly, a call set up by a user transferring user identification to a server, as taught by Gottesman, *is not* sending a message including a destination number from the mobile device to a callback computer, the message including information which requests a call from the mobile device to the destination number, as recited in independent Claim 1. The call made from Gottesman's exchange to the server does not request a call, and therefore Gottesman is silent on such a feature.

² See outstanding Office Action from page 3, line 20, to page 4, line 4.

³ See Gottesman in the Abstract, lines 2-5, and in Figure 1, steps A3-A5.

Therefore, even if the combination of Donovan, Kennedy and Gottesman is *in arguendo* assumed to be proper, the combination fails to teach every element of Applicants' independent claims. Accordingly, Applicants respectfully traverse, and request reconsideration of, these rejections based on these patents.⁴

Regarding the rejection of Claims 7, 9 and 11 under 35 U.S.C. §103(a), independent Claim 7 is amended to recite features similar to the features recited in independent Claim 1. Furthermore, the reference Kasai is concerned with a service to charge communication services to customers,⁵ and is entirely silent on sending messages including information to request a call, and establishing connection to a callback computer, and therefore does not remedy the deficiencies of Donovan, Kennedy and Gottesman. Accordingly, even if *in arguendo* the combination of these references is assumed to be proper, Kasai also fails to teach or suggest sending messages including information to request a call. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejection of Claim 7, and all associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 1.

Regarding the remaining 35 U.S.C. §103(a) rejections, since the rejections of independent Claims 1 and 7 are believed to be overcome, the rejections of dependent Claims 2-6 and 8-14 are also believed to be overcome. Furthermore, none of the applied references Walker, Kasai, Alvesalo, Joensuu, and/or Sjödin, taken individually or in combination, remedy the deficiencies of the references Donovan, Kennedy and Gottesman. All these references are silent on a message including information to request a call from the mobile device to the destination number, as recited in Applicants' independent Claims 1 and 7.

⁴ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

⁵ See Kasai in the Abstract.

Accordingly, Applicants respectfully request reconsideration of the remaining rejections of the dependent claims under 35 U.S.C. §103(a).

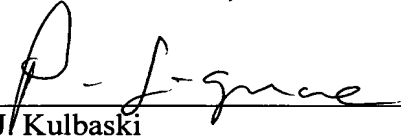
Should the Examiner continue to disagree with the above distinctions, Applicants respectfully request that the Examiner provide an explanation via Advisory Action pursuant to M.P.E.P. §714.13 specifically rebutting the points raised herein for purposes of facilitating the appeal process.

Consequently, in view of the present Request for Reconsideration, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-16 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Philippe J.C. Signore
Registration No. 43,922